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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER	
DINH, DUNG C	

ART UNIT	PAPER NUMBER
2152	9

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,211	STORY ET AL.	
	Examiner	Art Unit	
	Dung Dinh	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8/3/04 have been fully considered but they are not persuasive.

Regarding the 35 USC 102(b) rejection of claims 65-67 under Hooper, applicant argued that Hooper does not teach "multiple content counters ... indicate a current location of consumption...". The argument is not persuasive because Hooper has multiple pointers: a read pointer and a write pointer. Both pointers point to locations in the memory that stores the content and are incremented or decremented accordingly. Therefore Hooper meets the limitation "multiple content counters". The pointers are used together to indicate where to read and write data to the memory. Therefore the pointers indicate a current location of consumption as claimed.

Regarding the 35 USC 102(b) rejection of claims 32 and 34 under Fernandez, applicant argues that the examiner failed to point out where Fernandez teaches the limitation "most-recent episode of a series of digital content published at a first time." The argument is not persuasive because it is inherent that any new content (e.g. a new CD-ROM) received by the user would be the most-recent "episodes". Fernandez teaches loading a certain number of pages into the playback device and

automatically loading a certain number of subsequent pages [col.7 lines 50-54]. Hence, the first pages loaded are 'episode' published at a first time, and the subsequent pages are subsequent 'episode' published at a second time as claimed.

As per claims 40 and 70, Applicant argued that Fernandez does not provide motivation for automatic update of consumed content according to a user's specification. The argument is not persuasive because it is well known in the art that total automation is not always desired and that often it is preferable to have user manual control or configurable parameters. [See for example Baugher et al US pat. 5,819,043, which recognized that "a human being is the most adaptable control means yet devised." (col.3 lines 11-12). Hence, since Fernandez teaches automatic loading of subsequent pages before the current content is totally consumed, it would been obvious for one of ordinary skill in the art to let the user be able to specify the condition and the number of subsequent pages to be retrieved into the playback device to replace the pages currently stored in the playback device's memory.

As per claim 35, it has been amended to recite "dynamically changing" digital content. Applicant's argument is deemed moot in view of new ground of rejection below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooper et al. US patent 5,442,390.

As per claims 65, Hooper teaches a playback device comprising a memory to store digital content [col.2 line 2 memory buffer]; circuitry to maintain multiple content counters [col.2 line 5 write pointer and read pointer] indicating current location of consumption for digital content [col.2 lines 7-25].

As per claim 66, Hooper teaches digital content is updated based at least in part on the content counters [col.2 lines 7-17].

As per claim 67, Hooper teaches the playback device comprises an interface to receive digital content from a remote source [fig.12 interface 801].

Claims 32, 34, 68-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernandez US patent 4,855,725.

As per claims 32, 34, and 68-69, Fernandez teaches a method for providing personalized media comprising:

retrieving digital media content and storing the media content for subsequent playback (col.2 lines 27-42 - the process of creating a CD ROM database);

storing a subset of the media content in a playback device (CD book), wherein the subset of media is automatically selected to update consumed media content (see col. 7 lines 35-61). It is inherent that the content is no longer than a predetermined playback time in order to fit in the memory of the playback device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

Claims 33, 40-64, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez US patent 4,855,725.

As per claim 40, Fernandez teaches a method for providing personalized media comprising:

retrieving digital media content and storing the media content for subsequent playback (col.2 lines 27-42 - the process of creating a CD ROM database);

storing a subset of the media content in a playback device (CD book), wherein the subset of media is automatically selected to update consumed media content (see col. 7 lines 35-61).

Fernandez does not specifically disclose replacing consumed media according to a user predetermined specifications. Fernandez discloses the choice for replacing content is one of design and can vary with implementations (col.7 lines 55-60). It is well known in the art that total automation is not always desired and that often it is preferable to have user manual control or configurable parameters. Hence, it would have been obvious for one of ordinary skill in the art to provide a user determined specification for replacement of consumed media because it would have enabled the user to customize the retrieval of subsequent contents to meet his preference.

As per claims 33, Fernandez does not specifically disclose replacing consumed media according to a user predetermined specifications. The obviousness rationale is similar to the rationale as for claim 40 above.

As per claims 41, Fernandez does not specifically disclose the content being dynamic audio content. The type and format of the content clearly would have been a matter of design choice. It is well known in the art to replace dynamic content with most recent data. It would have been obvious for one of ordinary skill in the art to replace changing content with the most recent data because it would have enable the user to have data that is current.

As per claim 42, it is apparent in the system as modified that the segment is selectable by the user.

As per claim 43, Fernandez teaches determining segment length and media content and storing the selected segment (col.7 lines 25-27 - preceding 5 pages and 15 succeeding pages).

As per claim 44, Fernandez does not teach automatically storing the most recent segment. It would have been obvious for one of ordinary skill in the art to automatically store the most recent segment because it would have provided the user with the most up-to-date data.

As per claim 45, Fernandez teaches selecting a segment of the media content and storing in the playback device (col.7 line 5-7 - first 20 pages); determining an amount consumed and storing subsequence portion corresponding the amount consumed (col.7 lines 50-61).

As per claims 46-48, 52-56, they are rejected under similar rationale as for claims 40-45 above.

As per claim 57, it is rejected under similar rationale as for claims 40 above.

As per claims 58-64, whether the device is a dedicated audio device, a computer, or Internet terminal, and the type of storage used would clearly have been matters of design choice because the functionality of retrieving partial content for playback would have been functionally the same.

As per claim 70, it is rejected under similar rationale as for claim 40 above.

Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan US patent 5,761,485 and further in view of Kikisis US patent 5,727,159 and Belove et al. US patent 5,491,820.

As per claim 35, Munyan teaches a network comprising:

a server device (fig.1 #10) to store digital content and to provide the digital content to other devices on the network;

a playback device to store and to playback (fig.1 #1, fig.2) digital content.

Munyan does not teach a retrieval device coupled to the server device. Mighdoll teaches providing a retrieval device

(proxy) coupled to server devices for retrieving content on behalf of user devices such that it enable the system to improve transmission efficiency and latency in response to request from user devices (see abstract). Mighdoll teaches automatically update the content (col. 11 lines 50-60). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Mighdoll with Munyan because it would have improved the transmission efficiency and latency in providing content to the playback device.

Munyan does not teach the playback device stores a most-recent episode of a dynamically changing series of digital content and to have the digital content automatically updated from the server device with subsequent episode to store on the playback device. In similar field of invention, Belove teaches to provide dynamically changing series of digital content and automatically update content on the playback device according to storage parameter set by the user(col.9 lines 25-51, col.10 51-65). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Belove to Munyan because it would have provided for automatic updating content on the playback device according to the user specification.

As per claims 36-38, official notice is taken that server-push and client-pull technology to retrieve update data is well

known at the time of the invention. The usage of server-push or client-pull would have been a matter of design choice. It would have been obvious for one of ordinary skill in the art to use any one or both methods so as to provide update content to the playback device.

As per claim 37, Mighdoll teaches the retrieval device automatically retrieve updated content from the server device (col. 11 lines 50-60).

As per claim 39, Belove teaches the update content and unconsumed content approximately equal the first content (apparent by the user specified storage amount, col.9 lines 50-53).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dung Dinh
Primary Examiner
December 22, 2004